



**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Akira HIROSE et al.

Group Art Unit: 2191

Application No.: 10/806,127

Examiner: T. VO

Filed: March 23, 2004

Docket No.: 119191

For: INSTRUCTION FORM EXECUTION APPARATUS, INSTRUCTION FORM  
MANAGEMENT APPARATUS, INSTRUCTION FORM MANAGEMENT SYSTEM,  
INSTRUCTION FORM, AND INSTRUCTION FORM EXECUTION METHOD

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is attached. Applicants respectfully request review of the Final Rejection mailed December 31, 2007 regarding the above-identified application in light of the following remarks. This review is requested for the following reasons.

**I. The Pending Claims Recite Statutory Subject Matter**

The Office Action rejects claim 5-16 under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Office Action asserts that the rejected claims are directed to software *per se*. However, MPEP §2106.01(I) provides that finding claims directed to software *per se* is proper only when the claimed invention taken as a whole is directed to a mere program listing, *i.e.* to only its description or expression, it is descriptive material *per se* and hence non-statutory. The rejected claims recite more than a mere program listing. For example, at

least the storage part, output part and deletion part, as recited in claim 5, and similar parts recited in claims 8, 11 and 14, satisfy the requirements of 35 U.S.C. §101.

MPEP §2106.01(I) also provides that a computer program may be part of an otherwise statutory manufacture or machine. In such cases, the claim remains statutory irrespective of the fact that a computer program may be included in the claim. In other words, merely because aspects of a claim could be embodied by a computer program, does not render the overall claim non-statutory.

The Office Action asserts that the above features cannot "link" to a hardware feature because a storage part allegedly reads on a software element. This analysis is incorrect. Software *per se* cannot store, or output, data without some tangible embodiment. That is, a program listing itself does not store, or output, data.

Further, claims 5, 8, 11 and 14 recite, among other features, various apparatuses, such as the instruction form management apparatus and the instruction form execution apparatus. At least these features define structural features of the relevant apparatuses. As such, claims 5, 8, 11 and 14, and claims 6, 7, 9, 10, 12, 13, 15 and 16 for at least their respective dependence on claims 5, 8, 11 and 14, are understood to recite statutory subject matter.

## **II. The Pending Claims Are Definite**

The Office Action rejects claims 5-16 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed.

The Office Action asserts that the feature of an "instruction form," as recited in claims 5, 8, 11 and 14, is allegedly ambiguous. The analysis of the Office Action fails for at least the following reasons.

The Office Action asserts that the feature of an instruction form is not clear because of the deletion, recited in the pending claims, allegedly because deletion of an original template means that a user cannot get it back after deletion. The second paragraph of 35 U.S.C. §112

requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). The test for compliance with 35 U.S.C. §112, second paragraph, is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994). If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. *See, also, In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. *See, also, In re Warmerdam*, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

One of ordinary skill in the art would readily understand the term "instruction form" when read in the context of each of the independent claims. For example, each of the independent claims recites an instruction form that indicates a process to be executed to a document. Moreover, the meaning of this term is clear when read in light of the specification. For example, page 6, line 11 - page 7, line 5, of the specification describes the term "instruction form" with sufficient precision.

For at least these reasons, one of ordinary skill in the art would readily understand the term "instruction form" recited in each of the independent claims and thus, contrary to the Office Action's assertions, the term is not ambiguous. As such, the rejection of claims 5-16 under §35 U.S.C. §112, second paragraph is improper.

### III. **Specific Features Recited in the Pending Claims are Not Taught by the Applied Reference**

The Office Action, on page 6, rejects claims 5-16 under 35 U.S.C. §102(b) over Oracle9i case studies-XML applications, 2001 (hereinafter "Oracle"). This rejection is respectfully traversed.

MPEP §2131.01 states "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (emphasis added) *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987). This standard is not met here for at least the following reasons.

Oracle does not teach a storage part that stores an instruction form that indicates a process to be executed to a document by at least one of a plurality of instruction form execution apparatuses connected to the instruction form management apparatus, as recited in claim 5, and similarly recited in claim 14; and a generation part that generates an instruction form that indicates a process to be executed to a document by the at least one instruction form execution apparatus, as recited in claims 8 and 11.

The Office Action asserts that Oracle teaches a system with features that allegedly can be considered to correspond to these features. Oracle teaches a system that allows a user to fill in an order form which is then output to a supplier after the user clicks on "Place Order" (see, e.g., Fig. 8-5). Oracle further teaches that once the order form is output to the supplier, the data that was entered into the form is deleted (see, e.g., Fig. 8-5). Oracle, however, does not teach a storage part that stores an instruction form that indicates a process to be executed to a document or a generation part that generates an instruction form that indicates a process to be executed to a document, as recited in the pending claims.

As such, it is unreasonable to assert the Oracle anticipates the combination of features recited in claims 5, 8, 11 and 14, and claims 6, 7, 9, 10, 12, 13, 15 and 16 for at least their

respective dependence on claims 5, 8, 11 and 14, as well as from the separately patentable subject matter that each of these claims recites.

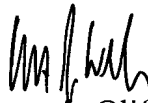
**IV. Conclusion**

In summary, claims 5-16 recite statutory subject matter, are clear and definite, and are not taught by the applied reference.

In view of the foregoing, Applicants respectfully request that the Review Panel review the substance of the December 31 Final Rejection in light of the above remarks. Applicants believe that upon such review, the Review Panel will determine that the Office Action's formal rejections of claims 5-16 are improper, and that Oracle does not anticipate the subject matter recited in claims 5-16. In this regard, favorable reconsideration and prompt allowance of claims 5-16 are earnestly solicited.

Should the Review Panel believe that anything further would be desirable in order to place this application in an even better condition for allowance, the Review Panel is invited to contact Applicants' undersigned representative.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Christopher J. Wheeler  
Registration No. 60,738

JAO:CJW/clf

Attachment:  
Notice of Appeal

Date: March 26, 2008

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**